

Appn. No. : 10/002,763

Grp./A.U. : 3671



**SUBMISSION**

**TO ACCOMPANY REQUEST FOR CONTINUED EXAMINATION**

**RESPONSE TO OFFICE ACTION OF 08/17/04**

**The following is the applicant's response to the Detailed Action sent 08/17/04:**

**1. Office Action:**

The application contained claims directed to patentably distinct species as embodied in the following:

- a) claim 57 of embodiment #7 shown in Figs. 6-A, BL, BR, CL, CR
- b) claim 81 of embodiment #1 shown in Figs. 1-A, B, C, D1, D2, D3
- c) Claim 88 of embodiment #14 shown in Figs. 13-A, BL, BR
- d) Claim 95 of embodiment #13 shown in Figs. 12-A, B, C
- e) Claim 99 of embodiment #3 shown in Figs. 2-A, B, C

Claim 111 – generic

The applicant is required to make an election of one species to be examined on the merits to which claims shall be restricted in case no generic claim is found allowable. The election of the specie must also include a listing of all claims readable thereon, including any claim subsequently added.

If a generic claim is found allowable, the applicant will be entitled to consideration of claims to additional species as provided by 37 CFR 1.141. If claims are added after the election, the applicant must indicate which are readable upon the elected species per MPEP 809.02(a)

2. Office Action :

A complete reply to the final rejection must include cancellation of non-elected claims or other appropriate action as stipulated in 37CFR 1.144 and MPEP 821.01.

**APPLICANT RESPONSE TO ELECTION OF SPECIE:**

To preclude any error or omission regarding the election of specie to be examined, the applicant is addressing the election issue before any arguments and remarks will be presented.

**According to Patent Rule 1.143 (Reconsideration for Requirement) in the event that the restriction requirement to one of the above species becomes final, the applicant is electing the specie as embodied in claim 88 and its dependent claims 89-94 and 110.**

Claim 88 is amended for further clarification of the elements. This amendment does not constitute new material.

Claim 94 is amended for spelling. The word “rube” in line 4 is corrected to “tube”.

Non-elected claims 81-87 and 106-109 however, will not be canceled but temporarily withdrawn from consideration subject to action pursuant to 37 CFR 1.144 for the following reasons:

- a) They could remain in the system for the Examiner to look at in case the applicant is able to convince the Examiner that the invention should not be restricted to either claim 88 or claim 81.
- b) According to the detailed office action, the election of specie must also include a listing of all claims readable thereon. It will be shown in section III below entitled “ Request for Reconsideration and Withdrawal and/or Modification” that claim 81’s dependent claim 108 reads into claim 88, claim

88's dependent claim 110 reads into claim 81. For this reason, claim 81 and its dependent claims must remain listed and not canceled.

While claim 81 and its dependent claims should not even be withdrawn, the applicant is doing so to clearly comply with the requirement of election regardless of traverse. Otherwise, this paper could be interpreted as non-responsive.

Accordingly, claims 57-61 and 116 are presently canceled.

Claim 81 is amended for grammar.

Claims 95-98 are presently canceled, its embodiment subject to reconsideration if a generic claim is found allowable. The figures that depict this embodiment include Figs. 10-A,B, 11-A,B, and 12-A,B,C.

Claim 99 is canceled.

Claim 110 is amended for clarification.

Generic claim 111 and its dependent claims 112 –115 and 117 remain for examination and subject to cancellation.

Claim 111 is amended for grammar. The word “comprise” in line 22 is corrected to “comprises”.

Claim 112 is amended for grammar and for clarification. The word “comprise” in line 3 is changed to “comprises” The word “hand grip” in lines 7 and 8 is replaced with “rake handle”. This is not new matter.

Claim 113 is amended for clarification.

New claim 117 is added, dependent on claim 111 to cover the pivotal connection.

**The statuses of claims are as follows:**

Claims 1-80 (canceled)

Claims 81-87 (withdrawn and pending)

Claims 88- 94 (pending)

Claims 95-98 (canceled pending allowance of a generic claim)

Claim 99-105 (canceled)

Claim 106-109 (withdrawn and pending)

Claims 110-115 (pending)

Claim 116 (canceled)

Claim 117 (pending)

**REMARKS AND ARGUMENTS:****I. Determination of Figures That Embody the Scope of claim 88 –94 and 110:**

Claim 88 includes the following basic elements: (Please refer to Exhibit B of Response sent by the applicant on 06/23/04.)

- a) a first and second rake units,
- b) the first rake unit having a first rake head and a first rake handle coupled to the first rake head,
- c) the second rake unit having a second rake head and a second rake handle coupled to the second rake head,
- d) each of the first and second rake units having an external side and an inner side,
- e) each of the first and second rake heads having an upper end and a lower end,
- f) the lower ends of the rake heads have a plurality of prongs,
- g) each of the first and second rake handles comprises an elongated member and a hand grip comprising a first branch extending transversely outwardly from

- the elongated member at a section intermediate the upper ends of the rake heads and the upper end of the elongated member,
- h) connecting means on the rake units for keeping the rake heads together during the raking operation and apart during the picking operation,
  - i) the raking operation substantially comprises a conventional method of raking,
  - j) the longitudinal axes of the rake handles sweep a raking plane during the raking operation,
  - k) the connecting means comprise a gripping connection on one of the first and second handles for releasably holding and abutting the first and second rake units in a side-by-side relationship towards their inner sides, the lower ends of the rake heads aligned during raking,
  - l) the gripping connection comprising a resilient member or its equivalent disposed on one of the first and second rake handles that snaps on and off the other of the first and second rake handles and directed substantially normal to the raking plane, and
  - m) the picking operation comprises the first and second hand grips and the first and second rake heads substantially facing each other and moving alternately toward and away from each other for grasping and releasing debris respectively between the first and second rake heads.

To determine the figures that embody the scope of claim 88, it is important to be aware of the word “**comprise**” in element (k) above. In patent language, the word “**comprise**” means “**including but not limited to**”. The word “comprise” makes claim 88 an open claim as is normally done in claim writing. Since the pro se applicant has not retained a patent attorney to back up this patent legalese, she is instead attaching a photocopy of page 9/19 (see Attachment A) of a patent reference book written by David Pressman, a patent attorney, entitled PATENT IT YOURSELF. The page explains the use of the word “**comprising**” vs. “**consisting**”.

In other words, claim 88 includes the elements (a) through (m) and optionally other connecting means. Please note that the picking rake having the gripping connection as stated in (k) and (l) above is novel, unobvious, thus patentable even if the gripping

connection is the sole connecting means used in the invention or combined with other connections disclosed or undisclosed in the patent application specifications. Therefore, a picking rake having elements (a) through (m) with or without a second connecting means is going to infringe on claim 88.

Having defined the scope of the connecting means in claim 88, all the figures in the patent application that have at least all the elements (a) through (m) above are considered within the scope of claim 88.

These figures include:

Figs. 1-A, A', B, C, D1, D2, D3

Figs. 2-A, B, C

Figs. 6-A, BR, BL, CL, CL'

Figs. 9-R, L, R', L'

Figs. 13-A, BL, BR

Fig. 32-B

Figs. 35-R, L

Fig. 38-A and

Fig. 39-A

Most of the rest of the figures in the disclosure are not included above simply because they do not show the two rake heads and two rake handles. However, they depict in greater detail the various parts and possible assemblages of the embodiment covered by claim 88 and its dependent claims. So, really, in effect, the alarming number of figures submitted by the applicant does not necessarily positively correlate to the number of independent claims that can be claimed. The numerous figures were provided in an effort to aid the examiner and/or lay judge in better understanding and determining the scope of the invention.

**II. Legal Limitations for Claim Language : “..means plus function..” specifically “..connecting means for..”**

Prior art may have main claims that have “ means-plus-function” language without even specifying or including a single particular connection. This claim writing technique was pointed out earlier in p. 5 of the response sent by the applicant on 6/23/04 particularly directed to the Mitchell patent. Patent Law 35 USC112 par. 6 states:

“An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”

This means that a prior art claim that simply states for instance: ”...connecting means for joining the two rake units together...” without mentioning at least one particular connection, is still limited to only the connections disclosed in the specification and its equivalents. The common approach to make a claim as broad as possible is to introduce each of the connecting means one at a time, using the word “comprise.” That way, even if only the first one of the connecting means is copied, and assuming all the other elements are copied as well, the claim is infringed.

The non-equivalence of elements (g), (k), and (l) above to any in prior art has been exhaustively argued earlier in previous OA responses and if the Examiner is convinced, this non-equivalence is sufficient to overcome prior art, thus patentable (only one non-equivalent element is necessary to overcome prior art). The addition of another connecting means like the pivotal connection as recited in dependent claim 110 or any other connection cannot limit the scope of the elements in main claim 88. A dependent claim cannot change or limit the scope of the parent claim. That is why, all figures that have both the gripping connection and the pivotal connection are considered within the scope of claim 88.

### **III. Request for Reconsideration and Withdrawal or Modification of Restriction Requirement**

**Reasons why restriction to either claim 81 or claim 88 should not be imposed:**

- a) The Detailed Action sent 08/17/04 admits on pp. 2-3 that the specie of claim 81 corresponds to embodiment #1 depicted in Figs. 1-A, B, C, D, D1, D2, D3. Claim 88 is depicted in these figures as well because the figures have all the elements of claim 88. The extra pivotal connecting means shown in these figures is implied in the word “comprise” of element (k) above and specified in claim 88’s dependent claim 110. The figures show all the elements of claim 110.
- b) An invention can include one or more elements that when used alone or together in conjunction with all the other elements produce a unique, novel, and unobvious working combination that is patentable. Two elements in this invention namely: the gripping connection and the pivotal connection can be used alone or together in addition with other elements to produce a patentable working picking rake. Exhibit C of the applicant’s previous OA response illustrates this concept. What holds for claim 57 in Exhibit C also holds for claim 88, although more broadly.

According to **MPEP 806.05 (c) : Subcombination Essential to Combination – No Restriction.**

Accordingly, if a combination ABCD comprises of subcombinations ABC and D or subcombinations ABD and C, and the subcombinations ABC and ABD are each separately essential distinguishing features of the invention ABCD, restriction should not be required.

For illustration purposes, let us assign the present invention as ABCD, the gripping connection as subcombination C and the pivotal connection as subcombination D. Without the optional addition of a pivotal connection (subcombination D), Claim 88 may be viewed as subcombination ABC. Without the optional addition of a gripping connection (subcombination C), Claim 81 may be viewed as subcombination ABD. The presence of two patentable subcombinations, ABC and ABD each separately usable (but not together) in the present invention ABCD therefore allows two separate approaches for writing claims. These are:

- 1) ABC plus option for D to produce combination ABCD - Claim 88 approach
- 2) ABD plus option for C to produce combination ABCD - Claim 81 approach



Therefore, the present invention should not be restricted to either claim 88 or claim 81.

- c) Allowance of claim 88 and its dependent claims will preclude the allowance of claim 81 and its dependent claims in a separate patent application for double patenting, and could even jeopardize the parent patent. This is because claim 81 will now be anticipated by claim 88's dependent claim 110; claim 81's dependent claim 108 reading into claims 88 and 110.
- d) Likewise, if the applicant had elected claim 81 and its dependent claims, the allowance of claim 81 and its dependent claims will preclude the allowance of claim 88 and its dependent claims in a separate patent application also for double patenting. This is because claim 88 will now be anticipated by claim 81's dependent claim 108; claim 88's dependent claim 110 reading into claims 81 and 108.

**Therefore, claims 88 and its dependent claims and claim 81 and its dependent claims must be allowed in the same patent if found patentable per MPEP 806.04 (h). There is no patent rule that restricts the allowance of more than one main claim. Prior art is replete with patents that have two or more main claims covering different approaches to claiming the same invention. Furthermore, the fact that the detailed action above requires the listing of all claims that read into the elected specie definitely supports this argument.**

- e) In the event that a generic claim is found allowable, and claims to more species added, claim 81 and its dependent claims should still be considered as a separate independent claim to cover the embodiment that has a pivotal connection even without hand grips. Claim 111 includes hand grips. The patentability of claim 81 is further argued in V below.

- f) In the event that no generic claim is found allowable, but main claim 88 and consequently its dependent claim 93 is found allowable, the specie covered in canceled claim 95 or 115 could probably be considered obvious over claim 93, thus both species might be unpatentable over each other if only for the reason that there is a very close semblance between Figs. 10-A,B, 11-A, B, 12-A,B,C depicting claim 95 and Figs. 13-A, BR, BL depicting claim 93. The tube component of the claim 95 very closely resembles the elongated resilient member or gripper of claim 93. The snap button of claim 95 has the same structure and function as the snap button of claim 93. Per MPEP 806.04(h), it is possible that claim 95 need not also be restricted.

With the provisional election and the reasons presented above, the applicant is requesting a reconsideration and withdrawal or modification of the requirement under Patent Rule 1.143. If the requirement is repeated and made final, the Examiner will at the same time act on the claims to the invention elected.

This request is required at this time in the event that a petition to the Commissioner to review the requirement becomes necessary pursuant to CFR 1.144.

Although this paper should be devoted mainly to making an election and arguing against the restriction, the applicant is also presenting a recap of arguments in support of the patentability of the pending claims. The applicant is also requesting the Examiner to further consider all the patentability arguments presented in previous OA responses.

#### **IV. Recap of Some Important Patentability Arguments for Claim 88**

**Claim 88 contains broadened versions of some of the elements in the original examiner- drafted and previously allowed claim 57. The term “removably connected” is replaced with “coupled”, a broader term but still within the scope of the present invention.** The term “removably connected” is not the distinguishing element to overcome prior art, therefore need not be specified. It just needlessly narrows down the claim. The words “removably connected” are still within the scope of the words “coupled” or “attached”. Using them does not overcome anything, thus, could be

avoided. According to 35 U.S.C. 103(a), patentability shall not be negated by the manner in which an invention was made. This patent rule exists for a very good reason. Crude prototypes made by independent inventors on limited budgets should not be used towards limiting and demeaning the underlying essence and scope of their inventions. A prototype disclosed in the figures as having a rake head “removably connected” to a handle may have been the only economically feasible option open to the inventor because the parts are affordable. That does not mean that a more affluent inventor that can afford to have a prototype made of a rake head and handle molded as one piece gets a broader patent.

**The location of the hand grips is also broadened because the mere presence and function of the hand grips already distinguishes from prior art.** The handle is recited as being made up of an elongated member and a hand grip. Then the gripping connection is recited as being on the rake handle and not specifically on portions of the hand grip. This allows for coverage of some versions of the picking rake where the longitudinal axis of the resilient member is parallel to the longitudinal axis of the elongated member and is proximal but not on the hand grip but still operating normal to the raking plane.

The **hand grips** perform functions the entire time the picking rake is used. They are held on to facilitate the forward and backward motions during the raking operation; they are held on to and “snapped” apart during the detaching operation; they are held on to during the picking operation; they are held on to, aligned and “snapped “ together during the attaching operation. And also importantly, their transverse positions and symmetry offer a more ergonomic hold than a standard rake handle.

Aligning the hand grips that are comfortably in sight of the user automatically aligns the rake heads as well in preparation for the next operation. In Mitchell, aligning the two parts requires aligning the semi-cylindrical member, 69, over the tubular member, 41, and/or aligning the hook , 91, with the opening, 97. This alignment method is significantly different from that of the present invention. In addition, it also requires some degree of precision directed to the part of the rake that is quite distant from the sight of the user. Unless the user is very far sighted, the user has to either stoop or lift the rake heads closer to get a better view of the parts to be aligned.

Except for the upper part of the longer elongated member that has to be held during the conventional raking operation, the elongated members are hardly held during the entire time the picking rake is used. The hand grips cover all handling requirements. No hand grip in prior art is assigned or is capable of these many functions. Mitchell's two rake parts are detached using the upturned rear end, 105, of the shorter handle. This may or may not be the part held on to during the attaching operation. This definitely is not the part of the handle held during the picking or raking operations. Actually, there is no specific portion of the handle designated for holding onto during the picking, attaching, and raking operations. It can be anywhere along the length of the handle. This method is no different than what is presently being done when two separate conventional rakes are used for picking debris. Therefore, the idea of a hand grip for all operations was never taught, implied or anticipated in prior art. This is why the mere presence and function of the hand grips can already distinguish the present invention from prior art. Where they are specifically located along the elongated member becomes irrelevant. Specifying its location will not only needlessly narrow the claim; it will also diminish its function. Its location is related to the user's arm reach that can therefore vary. The disclosure of the present invention does teach the variable location of the hand grips.

Mitchell has a handhold, 107 formed on the rake head. This again, is not equivalent to the hand grip of the present invention. The handhold is so far down on the rake, therefore, inaccessible for raking, attaching/detaching, and picking operations. The disclosure teaches its use to be an alternate hold when the small rake part is used as a shrub rake.

**While some elements are broadened, some are narrowed down, specifically those that are crucial and weigh heavily toward overcoming prior art. For the present invention, it is the detaching/attaching operation. The gripping connection is specified to comprise a resilient member that snaps on and off the other rake handle directed substantially normal to the raking plane swept by the longitudinal axes of the rake handles during raking. This element very significantly and can even singly distinguish the present invention from any prior art. No dual-headed and dual-handled rake in prior art that is used for the conventional method of raking, permanently or releasably connected, rake parts, overlapping or non-overlapping rake heads including**

Mitchell, can have their rake heads parted and connected for picking and raking operations respectively in the same manner as that in the present invention. All of the parting in prior art is done rotatably along the raking plane, limited by a connection or abutment that acts as a fulcrum and restricts movement beyond the raking plane. Even the completely detachable dual-headed rake of Mitchell can be attached and detached only in a clockwise and counter-clockwise rotational motion respectively along the raking plane. This is the case with or without the hook and opening connection on the rake heads.

The difference in the connection just described above is significant for two important reasons namely:

- a) The raking and picking operations using the picking rake become less of a chore. The operations approximate the natural and instinctive tendencies of a person when faced with a task that involves gathering, picking and disposal of things that require no bending or stooping. When this same natural tendencies are applied to a chore that would normally require stooping, like picking debris, the utility is doubled. The picking rake of the present invention embodies the tool provides this utility. The rake heads become extensions of the user's open hands, the side-directed parting handles extensions of his/her arms. The manner in which the rake heads separate in preparation for the picking operation very closely resembles what the hands would do. Very little thinking or concentration is required.
- b) The gripping mechanism for attaching and detaching the rake units operates only in a side-directed motion which is also normal to the raking plane, resulting in abutment of the rake units from separating along the raking plane. There is a natural tendency for dual- rake heads to separate along the raking plane during the raking operation because forces associated with raking act along this raking plane. Absent the presence of any connecting or abutment means, the short-handled part has the tendency to rotate upward during raking, thus, consequently gets detached. Mitchell's rake is actually abutted from separating sideways at all times - the very direction of operation of the gripping mechanism in the present invention. As was mentioned at greater lengths earlier in previous OA responses, the side-directed movement that

Mitchell considered as an attachment/detachment disadvantage, is considered an attachment/detachment advantage in the present invention. Since prior art teaches abutment against side-directed motion, the present invention could not have been anticipated by any of them. The operation of the gripping mechanism is novel and unobvious, thus patentable.

Please also note that the addition of the pivotal connection in an embodiment that already has the gripping connection (claim 88) does not in any way change the operation of the gripping connection. The pivotal connection is one that allows freedom of movement of the handles along planes swept azimuthally at least within 90 degrees from the raking position - planes wide enough to effect the side-directed operation of the gripping connection. Likewise, the addition of the gripping connection in an embodiment that already has a pivotal connection (claim 81) does not in any way change the operation of the pivotal connection. Each connection can accommodate the other.

## **V. Recap of Some Important Patentability Arguments for Claim 81**

The idea of also getting another claim allowed that is not limited by a gripping connection and the presence of hand grips was first advised to the applicant by a patent attorney consulted. The attorney pointed out that the novelty and unobviousness of just the pivotal connecting means and its method of use are sufficient to overcome prior art. This claim is claim 81.

Claim 81 is a workable picking rake despite the absence of the optional hand grips and the gripping connection. The element "... rake heads aligned forming substantially one functional rake head lying on one plane, at least one rake head contributing to the total raking span..." includes adjacent rake heads that can be overlapping or non-overlapping. In an overlapping rake head combination, one rake head supports the other. Preferably, the rake head coupled to the handle that is held by both hands when used for the conventional method of raking is made to support the other. Where the rake heads are non-overlapping, the words "connecting means....comprising...." covers the addition of another connecting means if needed.

While most of the figures do not picture overlapping rake heads, the disclosure (specifications – p. 22 under the subheading Rake Head Variation) nevertheless specifies that the rake heads may be overlapped. This is not new matter. The applicant can provide additional figures that show the picking rake with overlapping rake heads for inclusion if required.

Claim 81 is patentable because it is unique, novel, and unobvious over prior art mainly because of its pivotal connection. Similar to the gripping connection, the pivotal connection allows the picking rake to operate in a manner that approximates the natural and instinctive tendencies of a person when faced with the task of gathering and picking up things and without stooping. The rake heads become extensions of his/her open hands, the handles, extensions of his/her arms, the pivotal connection his/her shoulder joints that keep them all together as one unit. All transition operations flow almost seamlessly from raking to detaching to picking, to releasing, and to re-attaching and back to raking in accordance with the natural tendencies of the user. No re-learning, extra thinking, or extra concentration is required to get the job done.

Prior art connections for non-detachable dual -handled and dual-headed rakes limit movement to only one plane – the raking plane. Prior to picking, the entire rake (both parts together in the same direction) is turned about 90 degrees about its longitudinal axis. Looked in another way, the “raking plane” relative to the rake is actually shifted 90 degrees. This is done to effect a more natural and comfortable side-directed manner of grasping and releasing of debris during picking. In the present invention, at least one of the rake units is turned about 90 degrees separately and in opposite directions.

Accordingly, the difference in the manner in which the rake units are separated for picking affects the structure required of the tines or prongs on the rake heads. In prior art, the rake heads have to be completely overlapping so that they will not be askew during the picking operation. The prongs also have to be provided in opposite directions so that they can face each other during the picking operation. Prongs directed upward during the raking operation are rendered useless, non-aesthetic and even hazardous. The raking span is limited to just one rake head despite the weight of two. In other words, one

rake head is rendered useless while raking. All these are overcome in the present invention.

Because of the significant differences and advantages offered by the pivotal connection alone over any prior art connection, claim 81 should be allowed together with claim 88.

## **VI. Recap of Patentability Arguments for Claim 111**

Claim 111 has the following elements:

- a) a first rake unit having a first rake head and a first rake handle,
- b) a second rake unit having a second rake head and a second rake handle,
- c) each of the first and second rake heads has an inner side and an external side, a lower end and an upper end,
- d) the lower ends have a plurality of prongs,
- e) each of the first and second rake handles has an inner side and an external side,
- f) the first rake handle comprises a first elongated member and a first hand grip,
- g) the second rake handle comprises a second elongated member and a second hand grip,
- h) each of the first and second elongated members has a lower end and an upper end,
- i) the lower end of each of the elongated members are coupled to the upper end of their respective rake head,
- j) the first and second hand grip each comprise a first branch extending transversely from their respective elongated members at a section intermediate the upper ends of their respective rake heads and the upper ends of their respective elongated members,
- k) connecting means on at least one of the rake units for joining the two rake heads together in a raking position and for parting the two rake heads in a picking position,
- l) wherein the raking position comprises:



1. rake handles next to each other side-by-side along their inner sides,
  2. longitudinal axes of the rake handles substantially parallel (and distinct from each other),
  3. the rake heads adjacent each other towards their inner sides,
  4. the lower ends of the rake heads aligned forming substantially one functional rake head, and
  5. at least one rake head contributing to the total raking span,
- m) wherein the picking position comprises:
1. the two rake heads substantially facing each other, and
  2. the two hand grips substantially facing each other.

The arguments in support of the uniqueness of the hand grips as presented earlier in claim 88 also apply to (f), (g), and (j) of claim 111.

The “connecting means” of (k) above is not specified further in order to accommodate species that do not use the same type of connection. In accordance with the limitations set forth in 35 USC 112 par. 6 cited earlier, these connections can be the gripping connection (with or without the snap button) (claim 112), the pivotal connection (claim 117), or the tube and snap-button connection (claim 115). None of these connections have equivalents in prior art as argued exhaustively in this paper and in previous OA responses.

The words “distinct from ” in element (l)-(2) above may not be necessary in view of the following:

- a) the other distinguishing factors like the hand grips and the connecting means are already more than enough to overcome prior art,
- b) the pivotal and gripping connections can function with or without this element, thus, unnecessarily narrowing the dependent claims covering embodiments having these connections, and
- c) the words can instead be included inside a dependent claim for just the embodiment that has the tube and snap-button connection because the elongated member that goes inside the tube has a “closed” cross- section to

contain the snap-button; however, the connection is already novel and unique enough to overcome prior art that this specification should be optional.

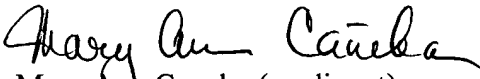
**In due fairness, if the Examiner concludes that claim 111 as written has more than enough distinguishing elements to overcome prior art and that its allowance does not hinge on the words “distinct from”, the applicant is respectfully requesting the Examiner to amend the claim accordingly by deleting the words “and distinct from” from lines 36-37 of claim 111.**

#### **Conclusion and Request for Constructive Assistance**

If the submitted claims are found to embody patentable matter but still not technically adequate, the applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to MPEP 706.03(d) and MPEP 707.07(j) in order that the applicant can place this application in allowable condition as soon as possible without the need for further proceedings.

Thank you.

Respectfully yours,

  
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ing surface. In this case simply start the claim, "In combination:" or "A process comprising:" and then recite the elements or steps and their interconnections.

- *Jepson Claims.* With regard to the rarely enforced Rule 75(e) (quoted in Section B2, above) requiring the use of Jepson (with a preamble containing old elements and body of claims containing improvements of your invention), most patent attorneys recommend that claims *not* be cast in this style unless the examiner requests it or unless the examiner is having trouble understanding exactly what your inventive contribution is. The reason for this is that a Jepson claim isolates and hence minimizes your improvement, making it easier to invalidate. If you do claim in the Jepson format, draft your preamble so that it includes all the elements or steps and their interconnections that are already known from the prior art; then add a "cleavage" clause such as "the improvement comprising" or "characterized in that"; and then recite the elements of your invention and their interconnections.

- *Predetermined.* Use the word "predetermined" to indicate that something has a size, thickness, length, quality, etc., without limiting the claim to any specific dimension or quality. For example, "said member having a predetermined cross-sectional shape" and "said valve arranged to open when a predetermined gas pressure is developed."

- *Consisting v. Comprising.* A claim that recites a group of elements can be made "open" or "closed." An open claim (the normal case) will cover more elements than it recites, whereas a closed claim is limited to and will cover only the elements it specifically recites. To make a claim open, use "includes" or "comprising"—for example, "said machine comprising A, B, and C." In this case, a machine with four elements A, B, C, and D will infringe. To make a claim closed (rarely done), use "consist" or "having only"—for example, "Said machine consisting of A, B, and C." In this case, a machine with elements A, B, C, and D will not infringe, since, in patent law, the word "consist" is interpreted to mean "having only the following elements."

*A Plurality Of.* Also, whenever you recite several units of anything, preface your recitation with "a plurality of"—such as, "a plurality of holes in said hose."

*Less Is More.* Remember that, because of the Boolean "less is more" rule in interpreting claims, it's not necessary to recite a specific feature in your main claim in order to cover that feature in combination with the other elements of your invention. For example, once I drafted a claim for a client where one embodiment of

her invention had a fingerlike support. Not seeing the finger in the main claim, she asked me, "Did you claim the finger?" I then explained to her that the main claim was broad enough to cover her invention with or without the finger.

- *Is It Sketchable?* After drafting your claim, you or a friend should be able to make enough sense out of it to sketch your invention. If this isn't possible, the claim is unclear and needs to be reworked.
- *Special Terms.* You can use any technical or descriptive terms that you feel are reasonably necessary to define or describe your invention—the claim does not have to be limited to any special "legalese." One patent attorney I know had a devil of a time defining (to the satisfaction of the examiner) a convex transistor structure with a nubbin on top until he simply called it "mammary-shaped."
- *Method Claim.* If possible, provide a method claim to cover your invention; you usually can do this if there's any dynamic operation involved in the invention. Most machines and electrical circuits can be claimed in terms of a method. Method claims are usually broader than apparatus claims, since they're not limited to any specific hardware.
- *Gerunds in Method Claims.* Each substantive clause of a method claim must usually start with an "\_\_\_\_ing" word, such as "attaching," "heating," "abraiding," etc. If you want to recite some hardware in a method claim, use "providing"—such as, "providing a central processor."
- *Label Means.* If you do recite any "means," it's desirable to label the means with a non-functional adjective in order to provide a mnemonic aid in case you need to refer to the means later. For example, "first means," "second means," etc. Also, the "means" must be followed by or be modified by a function or some structure. For example, "first means for printing" (means plus function); "second means comprising a doctor blade" (means plus structure).
- *Padding.* Lastly, many patent attorneys recommend that a claim not be too short. A claim that is short will be viewed adversely (as possibly overly broad) by many examiners, regardless of how much substance it contains. Thus, many patent attorneys like to "pad" short claims by adding whereby clauses, providing long preambles, adding long functional descriptions to their means clauses, etc. The trick here, of course, is to pad the claim while avoiding a charge of undue prolixity under Section 112.